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FILED
IN CLERK'S OFFICE
U.S. DISTRICT COURT E.D.N.Y.
★ FEB 07 2005 ★
LONG ISLAND OFFICE

February 7, 2005

HON DENIS R. HURLEY
FEB 8 2005

Honorable Judge Denis R. Hurley, U.S.D.J.
United States District Court
Long Island Federal Courthouse
843 federal Plaza

Re: Novak v. Overture Services, et al. No. CV 02 5164

Dear Judge Hurley,

Pursuant to this courts Order of January 20, 2005 relating to this case being dismissed and the case closed, plaintiff submits the following.

Defendant Overture submitted [89] its letter requesting dismissal, however both parties have reached a settlement and Overture will be filing today the appropriate documents with the Court.

Therefore, only the remaining defendant Google has a request pending for this courts consideration.

The court should be aware that plaintiff has attempted to resolve this trademark infringement litigation with Google's attorney Mr. Kramer on several occasions including February 1, 2005. To which not even a courteous response was received.

The reasons I desire to dismiss the case against the defendant are strategic. This defendant is defending the very same allegations of trademark infringement worldwide most notably in the SDNY by American Blind and Wallpaper 04-642 and Government Employees Insurance company (Geico) in the ED of Virginia 04-507. Google has also filed a complaint for Declaratory Judgment for Non-infringement in the ND of California 03-5340 against American Blinds all based on the same exact type of infringement.

I was awaiting a positive decision in the high profile Geico case which had gone in Geico's favor until trial in December of '04, based on that unfavorable decision and the American Blind and the declaratory judgment not as of yet being decided I felt that waiting for the ripening of those lawsuits would enable plaintiff to have precedent to come back to this Court an refile if those courts found infringement. Or in the alternative Google would change their blatant practice of selling trademark protected keywords.

I. Can plaintiff retroactively condition the dismissal request.

Prior to filing the dismissal request plaintiff contacted defendant's attorney Mr. Slafsky and informed him of my intention to dismiss. Nothing was discussed as to the dismissal being with or without prejudice, nor were any other issues discussed, he seemed satisfied that the case would come to close.

The Notice of Voluntary Dismissal did not state that the dismissal would be conditioned at all. It only stated "Robert Novak, hereby dismisses all claims of this action against Defendant's"

The Notice should be reviewed not only for what it states but also for what it doesn't state. It was the plaintiff's position that not stating "with prejudice" means without prejudice.

The defendant would have needed to make a settlement to have that stipulation. Based on defendant's telephone conversation never raising an issue of prejudice, they are a dollar short and a day late.

Therefore, this courts 12/22/04 Order should be entered.

II. Clerks failure to enter.

Plaintiff filed the request for dismissal on December 20, 2004, Google waited until December 29th to file only a letter requesting dismissal with prejudice. Should the proper procedure have been to file an Appeal or Motion?

Should the plaintiff now be prejudiced by the clerk's failure?

I can only leave those issues to this Court to decide.

III Should case be dismissed with or without prejudice.

The purpose of Rule 41(a)(2) is to prevent "voluntary dismissals which will prejudice the opposing party . . . ." *Shulley*, 115 F.R.D. at 51 (citing *John Evans Sons, Inc. v. Majik-Ironers, Inc.*, 95 F.R.D. 186, 190 (E.D. Pa. 1982)); 9 Wright & Miller § 2364.

In determining whether a dismissal would deprive the Defendant of a substantial right, the Court should consider: "1) the excessive and duplicative expense of a second litigation; 2) the effort and expense incurred by the defendant in preparing for trial; 3) the extent to which the current suit has progressed; and 4) the [P]laintiff's diligence in bringing the motion to dismiss." *CitizensSav. Ass'n.*, 120 F.R.D. at 25. A party will not suffer prejudice simply because the Plaintiff "proposes to refile his claim in another court or seeks some tactical advantage . . . ." *Pouls,* 1993 U.S. Dist. LEXIS 11134 at 3; *See also Selas Corp. of America v. Wilshire Oil Co.*, 57 F.R.D. 3 (E.D. Pa. 1972).

Plaintiff states the Voluntary Motion to Dismiss does not prejudice Google because the parties have not conducted meaningful discovery, no trial date has been set and no motions for summary judgment are pending.

Defendant's effort and expense have not been excessive appearing in this case. Their own motions and shenanigans have caused the majority of their expense.

This case has not progressed so far as to make dismissal prejudicial.

Dismissal of the action will leave the Defendants in a position that is essentially no different from the position they occupy today.

Google has not made a claim that they would be deprived of any substantial rights.

IV Defendant's request for counterclaims.

It is interesting that in the Google letter of December 29th they ask that their counter claims be dismissed specifically *without* prejudice but plaintiff's claims *with* prejudice. Their request is not equitable.

Conclusion.

Plaintiff requests that this court find that the case be deemed closed and both parties' claims are dismissed without prejudice and upon such terms and conditions as the court deems proper.

Respectfully submitted,

Robert Novak

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